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to purchase them as plaintiffs' nails. The defendant has not imitated their label, for they have none. He has not even imitated the plaintiffs' manner or style of putting up their packages; there is nothing beyond the mere averment that he makes a similar nail. We have never yet carried the doctrine of trade-marks to the extent claimed for it by the plaintiffs. We have never hesitated to restrain the imitation of a trade-mark where the facts justified it. We are now asked to go one step further and protect the manufacture of the article itself. This we do not see our way clear to do. The manufacture of a particular article can only be protected by a patent. The law in regard to trade-marks should not be pushed to the extent of interfering with manufactures. A man may make any article that he please that is not protected by a patent. He may make a horseshoe-nail or any other unpatented article precisely like that of any other manufacturer; he may imitate it so perfectly that the one may be mistaken for the other, but he may not sell his own article as and for that of another by means of a trade-mark in imitation of the trade-mark of such other person. Some of the cases cited go so far as to restrain one manufacturer from imitating the style, form and size of the packages of other manufacturers. We need not discuss these cases, as they are not applicable. Our attention has not been called to any case which is authority for plaintiffs' claim.

We think judgment was properly entered for the defendant upon the demurrer.

The degree is affirmed, and the appeal dismissed at the cost of the appellants.

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*Supreme Court of Pennsylvania.*

HOYT v. HOYT.

SYLLABUS.

Where a name, style of label, style of package, etc., incapable of becoming technical trade-marks, are adopted by a man to distinguish his goods from similar goods of other people, the use of this name by a person otherwise entitled to it, and the imitation of the labels, packages, etc., for the purpose of deceiving purchasers and passing off his goods as those of the first man's, will not be restrained by a Court of Equity.

Plaintiff, whose name was Hoyt, had manufactured cologne for many years and obtained a reputation for it. To distinguish from the cologne of other manufacturers he called it "Hoyt's German Cologne," and used certain distinctive labels, packages, etc., in connection with it.

Defendant, whose name was also Hoyt, and who also manufactured cologne, called his cologne "Hoyt's Egyptian Cologne," and imitated plaintiff's labels, packages, etc., to take advantage of plaintiff's reputation, deceive purchasers, and pass off his goods as those of the plaintiff.

*Held:* The plaintiff had no exclusive right to the use of the word "Hoyt's;" that the word was not a trade-mark; that the distinctive labels, packages, etc., were not trade-marks, and therefore the plaintiff was not entitled to relief.

#### STATEMENT OF THE CASE.

This was a bill in equity, brought by E. W. Hoyt & Co. against F. Hoyt & Co., praying for an injunction and an account. The complainants' bill averred that the plaintiffs had been engaged since 1870 in making and selling cologne under the name of "Hoyt's German Cologne," and had designed three sizes of bottles for this cologne, calling them large, medium and trial size; that in 1871 they had originated a cap label for the top of the bottle, and a paper label for the body of the bottle, which labels with the bottles were their exclusive trade-marks, and the word "Hoyt's" their exclusive trade name; that the plaintiffs had been the first to use the name "Hoyt's" as applied to cologne; had always been associated in the public mind with the plaintiffs' cologne, and that the use of that name upon cologne by another would tend to mislead and deceive the public and be a fraud on the plaintiffs; that in 1871 the plaintiffs had copyrighted their said face label, and in 1877 received a certificate of the registry in the Patent Office of the United States of the said label and trade-mark.

That in 1885 the plaintiffs learned that the defendants, who were manufacturers of cologne in Philadelphia, had been exposing for sale cologne called "Hoyt's Egyptian Cologne," in three sizes, and also a size called "Hoyt's Aline Cologne," with labels similar to the plaintiffs', likely to mislead purchasers and induce them to believe the same was the plaintiffs' cologne. That the defendants, by selling cologne under trade-marks similar to the plaintiffs', had injured them and deprived them of sales and profits.

The plaintiffs, therefore, prayed for an injunction restraining the defendants from selling any cologne in bottles with labels and caps as described ; from using the caps and labels described as plaintiffs' labels, and from imitating the trade-marks, bottle-caps, advertisements and packages used by the plaintiffs, and from the use of the word " Hoyt's " on all labels and advertisements of every form in connection with the sale and manufacture of cologne.

The defendants' answer set forth that the plaintiffs were not entitled to equitable relief because they were guilty of deception and misrepresentation in offering their cologne as German cologne when it was an American production ; that in 1876 one of the defendants had adopted a trade-mark, which was duly registered, and denied the allegations of the plaintiffs' bills. Affidavits were filed by both sides, and a motion was then made by the plaintiffs for a preliminary injunction on bill, answer and affidavits ; and the Court, Thayer, P. J., entered a decree restraining the defendants from the use of bottles or cap labels on bottles resembling in shape and general appearance the plaintiffs' bottles as described in the bill.

The case was then referred to an examiner and master, who found, as a matter of fact, that there was no cologne of foreign manufacture known to the trade and public under the designation of German Cologne ; that the plaintiffs had, by their energy, industry and liberal expenditure of money, secured a large sale in the United States of cologne of their own manufacture, put up in bottles of their own devising and of peculiar shape, with labels printed in an original combination of colors, packed in a distinctive manner, sold under the name of " Hoyt's German Cologne," and known in the trade by that name, and also by the name of " Hoyt's Cologne."

That the defendants had been and were manufacturing and selling cologne, and had intentionally imitated the plaintiffs' bottles, labels and method of packing, and had thereby put themselves in the position of selling as goods of the plaintiffs' manufacture goods which were really of their own manufacture, and they had thereby appropriated to themselves the benefit of the plaintiffs' advertising and business reputation.

Upon this state of facts the Master decided as a matter of law that there was no just inference of fraudulent intent on the part of the plaintiffs in the use of the word "German" on their

labels designating their cologne as "Hoyt's German Cologne," particularly since the plaintiffs put their name and the place of manufacture upon the bottles they used, and that therefore the plaintiffs were not to be denied equitable relief if otherwise entitled to it. And held that the following general doctrine as stated by the Langdale, M. R., in *Perry v. Truefitt* (6 Beav. 66), applied to the case: "A man is not to sell his own goods under the pretext that they are the goods of another man; he cannot be permitted to practise such a deception, nor to use the means which contribute to that end. He cannot, therefore, be allowed to use names, marks, letters or other indicia, by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person."

The Master decreed (1) That a writ of injunction issue restraining the defendants and their agents and servants from putting up, selling, exposing or offering for sale, cologne in such bottles as were in the plaintiffs' bill, described as the plaintiffs' bottles, with cap labels or front labels as described in the plaintiffs' bill or otherwise imitative of the plaintiffs' labels. (2) That a writ of injunction issue restraining the defendants, their agents and servants, from issuing the word "Hoyt's" as the initial word of the description of their cologne upon any advertisement, label or bottle of any cologne offered or exposed for sale by them. (3) That a writ of injunction issue restraining the defendants, their agents and servants, from putting up, or selling or offering for sale, cologne in any boxes or bottles, or with any labels simulating or imitating the plaintiffs' bottles, boxes or labels. (4) That an account be taken of the defendants' sales of cologne as made in boxes or bottles or with labels imitating the plaintiffs' boxes, bottles and labels, and the defendants are thereby ordered to pay to the plaintiffs such sums of money as by the said account shall be found to be due and payable by them.

The defendants took exceptions to the Master's decree, but the Court below affirmed the decree.

The defendants then appealed to the Supreme Court, which, in the following opinion by WILLIAMS, J., dismissed the bill at the cost of the appellees, as no ground of equitable relief appeared on the face of the record.

## OPINION OF THE COURT.

The cases in which a Court of Equity will interfere to protect a trade-mark are divisible into two classes. To the first of these may be referred those cases in which the trade-mark has been registered under a system provided by law for the protection of the owner in its use. To the other belong all those cases in which there has been no registration, and in which the true ground for interference is the prevention of fraud. In cases falling within the first class, property in the trade-mark is shown by the certificate of registration. In those belonging to the second, the right asserted is of common-law origin, and is shown by proof of the adoption and use of the trade-mark. Its invasion is a fraud upon the owner and the public, to be restrained on principles of common right. All monopolies are odious, and their maintenance in favor even of inventors is limited in duration. When a statutory term of protection is over, whatever is valuable in the subject of the patent becomes, as does an unpatented invention, a contribution to the public welfare and may be freely used as such. Competition is essential to commerce, and within legitimate lines should always be encouraged. The "survival of the fittest" is a law of trade no less than of the development of living organisms; and from the struggle which determines who and what is "fittest" come general development and progress. As a general proposition, it may be said that one may imitate what is excellent in the processes and business methods of his neighbor as freely and as safely as he may imitate what is good in his moral character as long as he infringes no right secured to him by statute, and does not fraudulently personate him or simulate his products. An inventor who secures a patent for his device is protected in his exclusive right during the period fixed by law. When that period expires his exclusive right expires with it, and thereafter he stands on no higher ground than any other citizen who may desire to use the thing or combination covered by the patent. The rules applicable to trade-marks are quite different. A trade-mark may increase in value to its owners by use, and the law could not put a time limit on the owner's right to it any more than it could put a limit upon his right to use any other article or property. A trade-mark is not an invention. It does not relate to or affect processes of manufacture or mechanical combinations. It is a sign or mark

by which the manufactured articles produced by one person or firm or maker are distinguishable from those produced by rival manufacturers. It must be distinctive and indicate the personal as distinguished from the geographical origin of the article to which it is applied: *Laughman's Appeal*, 128 Pa. 1. Thus *Sonman*, the name of a large tract of land, cannot be appropriated by one of several owners of land within the tract, to the exclusion of the other owners; nor *Lackawanna Valley*, by one operator in that valley, to the exclusion of all others. But the trade-mark must relate to and distinguish the goods to which it is applied. For this reason, among others, the size or shape or mode of construction of a box, barrel, bottle, or package in which goods may be put is not a trade-mark. If there is any new and useful combination in the construction of such box or package it should be patented as an invention, if the owner wishes to prevent others from using it; but such package cannot be registered as a trade-mark. A sign, devise or mark originated and in actual use by another cannot be adopted and registered by any one who takes a fancy to it as his trade-mark, and such adoption and registration will not confer a title on him who makes it. It would be an infringement upon the original owner, and from the wrong so done no valid title could grow. A trade name may, in a general way, be treated as a trade-mark and protected in the same manner. When a business has been conducted by some person or firm under a particular trade name until the public come to regard the name as affording an assurance of the good quality of the article bearing it, the name is a valuable part of the business assets of the person or firm whose skill and integrity have won confidence for it. A rival who should appropriate the trade name to his own use without the consent of the owners, and put his goods on the market bearing it, as though they were made by the rightful owner of the trade name, is guilty of a fraud on the public, and a fraudulent taking from the proprietor, which is, both in intent and effect, a larceny.

But when such rival puts his goods on the market on their own merits and under his trade name, his neighbors have no just ground of complaint if he has imitated, adopted, or improved upon their unpatented methods and processes: *Putnam Nail Co. v. Dulaney*, decided at the present term. It only remains to apply these general principles to the case now before

us, so far as they are applicable to the questions raised by the appeal of the defendant below. The plaintiffs claim that the front or face label on their bottles has been registered by them as a trade-mark. It is put on obliquely to the length of the bottle. It bears the name of the liquid in the bottle thus, "Hoyt's German Cologne." It also bears the name and residence of the makers, and a reference to the fact of its registration. They also claim the following unregistered trade-marks: a bottle having a depression or panel on the back side; a cap label over the cork in the bottle; a peculiar mode of arranging and packing bottles in boxes; in the name of the article sold, viz., "Hoyt's German Cologne."

The defendants have a registered label or trade-mark which goes upon the bottle at right angles with its length, and which contains the name of the liquid, "Hoyt's Egyptian Cologne," with a view of a pyramid and the head of the sphinx; with the names and residence of the makers, and a reference to its registration. The learned Judge of the Court below held that F. Hoyt, of the defendant firm, had a legal right to use his own name in his business, and that he could not be enjoined from using it upon goods produced by himself. The correctness of this holding is not raised by the defendants' appeal. The learned Judge also held that the defendants' trade-mark or label was not an infringement upon that of the plaintiffs', whether considered by itself or in connection with the champagne-shaped bottles on which it was originally used by the defendants. This also must be regarded as settled for the purposes of this appeal, since the plaintiffs have not appealed, and the defendants cannot, from this ruling. Then, too, the evidence shows very clearly that the bottle with the depression or panel on the back side, which both parties are now using, is a stock bottle to which neither of them has any exclusive right, and which is freely sold by manufacturers to all who apply.

This bottle, as we have already seen, is not a trade-mark. It is not registered, and it is not capable of registration. It is in common use, open to the purchase and use of all who may fancy its shape, in the same manner as the other stock bottles. *The cap label was not originated by the plaintiffs, and does not belong to them. It was devised, according to the uncontradicted testimony, by Dr. David Jayne, a Philadelphia chemist and dealer in medicines, and was used by him and his successors for years before*



*and since the plaintiffs assumed to adopt it as their own. Their adoption of his cap label gave them no title to it.* The mechanical arrangement of the bottles in boxes is neither an invention nor a trade-mark. If the box is an invention, and others are to be prevented from using it, the plaintiffs should have secured a patent for it. Without letters patent they have no exclusive property in the shape or construction of a box. Whatever one manufacturer or tradesman may do to increase the safety of his goods in transportation, or to display them advantageously upon shelves, counters, or in show windows, is simply a good example or model for the public which any one interested may imitate with impunity. The debatable ground presented by this appeal is thus seen to be very narrow. It may be learned to the best advantage by considering the language of the Court below and the form of the decree made. The decree did not hold the defendants' label to be an infringement, or deny the defendants the use of their name. On the contrary, the learned Judge said, "The defendants have also, we think, the right to use the label placed on the sides of their bottles."

If they made cologne and sold in bottles such as they used at first, with their labels upon them having the name "Hoyt's Egyptian Cologne," and the pyramid and the head of the sphinx, and the names and residence of the makers, they were exercising a clear legal right and could not be enjoined. "But," the decree continues, "the defendants must be enjoined from putting up and offering for sale cologne in the bottles described in the bill, with the labels thereon." This is the decree appealed from. The Court held that the defendants' label was no infringement, and was lawfully used on a stock bottle with a champagne-bottle shape. But if the same label was used on another stock bottle having a panel on the back side, it became an infringement because of the shape of the bottle on which it was placed, and the use of the label on such a bottle must be prevented by injunction. As both styles of bottle were open to the public as stock bottles, the label was as lawful upon one of them as upon the other. The plaintiffs could no more acquire an exclusive right to a stock bottle by priority of use than they could acquire an exclusive right to Dr. Jayne's cap label by being the first to appropriate it without his knowledge or consent. Adopting the conclusions of the learned Judge, that the label of the defendants did not infringe upon that of the

plaintiffs, and that the defendants had a legal right to use their own names in their business, we cannot sustain this decree.

It is accordingly set aside ; and as no ground of equitable relief appears upon the record before us, the bill is dismissed at the cost of the appellees.

The facts in these two cases, though differing somewhat, are such that the same principles apply to them both. In each case the bill claimed not only a trade-mark for the plaintiffs and an infringement of it by the defendants, but further averred an imitation, by the defendants, of certain distinctive marks, etc., whether trade-marks or not, used by the plaintiffs to distinguish their goods, with the intention, on the part of the defendants, of deceiving the public and purchasers, and inducing them to believe that the defendants' goods were the plaintiffs', and in one case that purchasers had thereby in fact been deceived, and in the other case that the plaintiffs were thereby deprived of sales and profits. In the first case the defendants admitted the facts averred in the bill by demurring to it, and in the second case the Master and the Court below found the facts as stated in the bill to be true. The Supreme Court of Pennsylvania in the first case decided that the plaintiff had not a good trade-mark, and in the second that the registered trade-mark had not been infringed, and in both cases, totally ignoring the imitation by the defendants of the marks, labels, etc., adopted by the plaintiffs to distinguish their goods, dismissed the bills.

It is thought that an examination of the cases will show the Supreme Court of Pennsylvania, in so deciding, failed to recognize a principle that is clearly laid down and followed by the English Courts, the Supreme Court of the United

States, and the Courts of last resort of many of the States.

A trade-mark is " a symbol, emblem, or mark, which a tradesman puts upon or attaches in some way to the goods he manufactures, or has caused to be manufactured, so that they may be identified and known in the market " (Bouvier's Law Dictionary).

This is a trade-mark in its broad sense. In its narrower or technical sense, and it will be used in this sense in this discussion, there are certain limitations in determining what can be made a trade-mark, for not every symbol, emblem or mark can be taken as a trade-mark. In certain cases, though a man was the first one to use the mark, others have as good a right to it as he, and he cannot appropriate it exclusively to himself. A man cannot use his own name as a trade-mark for his goods (Brown on Trade Marks, 206), nor can he adopt a name descriptive of natural objects as such (Laughman's Appeal, 128 Pa. 1), and there are certain other limitations as to what may be adopted for a trade-mark.

Where the descriptive emblem, symbol or mark is such as to be a technical trade-mark, its owner can have it registered, and has an absolute possessory right to it as against the world, and any infringement of such a trade-mark, whether fraudulent or not, will be restrained.

If the law of trade-marks were limited to technical trade-marks, there would often be great injustice done. A. has adopted, we will

suppose, a device or mark of such a nature that it cannot be made a trade-mark; his goods are of a superior quality, and purchasers prefer them to the goods of other manufacturers, and in making purchases look out for A.'s distinctive device or mark. B. imitates A.'s device or mark for the purpose of deceiving purchasers and passing off his goods as A.'s. B. has just as good a right to the use of the device or mark as A., except for the fact that A. has established a reputation for his goods and has used the device or mark to distinguish them from the goods of other manufacturers; yet there would here be a clear fraud upon A. and those who desired to purchase his goods if B. were allowed to pass off in this way his goods for the goods of A.

To prevent such a fraud, a principle of law has been developed called the law of cases "analogous to trade-marks."

The gist of this doctrine is not the infringement of a trade-mark—for the device or mark imitated is not capable of becoming a trade-mark—but is the fraudulent imitation by one man of some distinctive device or mark adopted by another to distinguish his goods from other goods of the same character. The principle that applies in such cases is very clearly and forcibly laid down by Lord Langdale in *Perry v. Truefit*, 6 Beav. 66: "A man is not to sell his own goods under the pretext that they are the goods of another man. He cannot be permitted to practise such a deception, nor use the means which contribute to such an end." (See an article on "Cases Analogous to Trade-Marks" in the *Harvard Law Review* for February, 1891, by G. O. Cushing, Esq.,

and one on "The Prevention of Unfair Competition in Business" in the *Harvard Law Review* for October, 1891, by Rowland Coxe, Esq., for excellent treatment of this subject.) The English cases have recognized this principle for many years.

In *Knott v. Morgan*, 2 Keen 213, decided in 1836, the plaintiffs, who ran a line of omnibuses, painted their omnibuses and clothed their servants in a special and distinctive manner, and the defendants began to run omnibuses painted in the same manner, with servants similarly clothed. The defendants were restrained from imitating the plaintiffs' line of omnibuses, though it did not appear that the plaintiffs had any exclusive right to the style of painting or clothes imitated. Per Lord Langdale: "It is not to be said that the plaintiffs have any exclusive right to the words 'Conveyance Company,' or 'London Conveyance Company' or any other words; but they have a right to call upon this Court to restrain the defendants from fraudulently using precisely the same words and devices which they have taken for the purpose of distinguishing their property, and therefore depriving them of the fair profits of their business by attracting customers upon false representation that the carriages (really the defendants') belonged to, and are under, the management of the plaintiffs."

In *Perry v. Truefitt*, 6 Beav. 66, the plaintiff was the compounder of "Perry's Medicated Mexican Balm," and the defendant was restrained from calling another compound under the name of "Truefitt's Medicated Mexican Balm." Per Lord Langdale: "I own it does not seem to me that a man can acquire property merely in a name or a mark; but whether he has or has not a property in the name or mark, I have no doubt that another

person has not a right to use that name or mark for the purpose of description."

In *Croft v. Day*, Beav. 84, the plaintiffs, executors of the surviving partner of the firm of Day & Martin, of 97 High Holborn, sold blacking made by them in bottles labelled with the name and address of the firm. The defendants, who obtained the authority of a man named Martin to use his name, and sold blacking in bottles with the name and address "Day & Martin, 90½ Holborn Hill," in imitation of the genuine labels, was restrained from using labels or show cards calculated to produce deception. In *Lee v. Haley*, L. R. 5 Ch. 155, the plaintiffs, under the name of the "Guinea Coal Company," sold coal at 22 Pall Mall. The defendant, a former manager, started to sell coal at number 46 Pall Mall under the name of the "Pall Mall Guinea Coal Company," but was restrained from trading under that name in Pall Mall.

Per Gifford, L. J.: "I quite agree that the plaintiffs have no property in the name (Guinea Coal Company), but the principle upon which cases upon this subject proceed is not that there is a property in the word, but that it was a fraud on a person who has established a trade and carries it on under a given name, that some other person should assume the same name, or the same with a slight alteration, in such a way as to induce persons to deal with him under the belief that they are dealing with the person who is given the reputation of the name."

In *Siegert v. Findlater*, Chan. Div. 801, the plaintiff manufactured at Angostura a liquid which he called "Angostura Bitters." The defendant began to make another

preparation which he called "Angostura Bitters" and sold in bottles like the defendant's. Held that the defendant had acted in a manner intended and calculated to deceive and which had deceived; and he was restrained from using the word "Angostura" or the words "Angostura Bitters" in such a way as to be calculated to deceive.

In *Thorley's Cattle Food Co. v. Massam*, 42 L. T. N. S. 851, and *Lever v. Goodwin*, L. R. 36 Ch. Div. 1, and *Milner v. Reed*, Cox's Man. T. M. C. 328, the same principle is recognized and followed.

In *Walker v. Alley*, 13 Grant Up. Can. Ch. 366, the plaintiff had established a dry-goods house under the sign and name of the "Golden Lion," and the defendant began a similar business under the same name and sign. The Court granted an injunction and said: "You have your choice of many signs which, as a mere attraction or to give your store a marked designation, must answer a fair business purpose equally well." See also *Wolf v. Hart*, 4 Victoria L. R. Eq. 125.

Finally, two late English cases emphasize strongly the principle of equitable relief in cases entirely outside of technical trade-marks where there has been fraud. In the earlier one, *Witherspoon v. Currie*, L. R. 5 H. L. 508, the plaintiffs made starch at Glenfield which obtained a reputation under the name of "Glenfield Starch." Subsequently the defendants moved to Glenfield and made starch which they sold as "Glenfield Starch." Although the starch was made in Glenfield, the defendants were restrained from calling it Glenfield Starch, as doing so would be calculated to produce in the mind of purchasers the belief that it was the plaintiffs' article.

So also in *Thompson v. Montgomery*, L. R. 41 Ch. D. 35, the plaintiffs had a brewery at Stone, and called their ale "Stone Ale." The term became well known in the market, and the plaintiffs sought to prevent the defendant calling his ale "Stone Ale," though in point of fact it was made at Stone. The Court said: "The plaintiffs' rights are to prevent anybody from passing off their goods as the goods of the plaintiffs'. The defendant says that the plaintiffs have no exclusive right to the use of the words "Stone Ale" alone. Perhaps not, as against the word. He says that the plaintiffs have not any right to prevent the defendant's selling his goods as having been made at Stone: I am not prepared to say that they have. But as against a particular defendant who is fraudulently using, or going to fraudulently use, the words with the express purpose of passing off his goods as the goods of the plaintiff, it appears to me that the plaintiff may have rights." The injunction was accordingly made perpetual.

Turning now to the American cases, we find the same principle followed, time and time again, in Federal and State Courts.

In *Enoch Morgan's Sons Co. v. Schwachofer*, 5 Abbott's New Cases 265, the plaintiffs were manufacturers of a soap which they called "Sapolia" and wrapped in silver foil with a blue band. The defendants manufactured a similar soap which they called "Saphia," also using a silver foil and a blue band for the packages. An injunction was granted to restrain the defendants from using wrappers so closely resembling the plaintiffs', the Court saying:

"I am, therefore, of the opinion

that the plaintiffs are entitled to an injunction restraining the defendant from vending 'Saphia' in the blue packages in which it was sold. By this I do not mean to be understood as holding that the defendant has not the right to manufacture, and also to sell, 'Saphia,' nor to restrain him from the use of that name, or the figure or device upon the label, but I do intend that he shall abstain from dressing his goods in wrappers so closely resembling the plaintiffs' as to enable him to deceive the public and perpetuate fraud. In other words, he must sell under his own colors, and not under those of the plaintiffs'."

See also *Williamson v. Johnson*, 2 Bosw.; *Gillott v. Esterbrook*, 48 N. Y. 374.

In *Morgan's Sons Co. v. Troxell et al.*, Cox's Man. T. M. C. 674, Barrett, J., says: "Are the defendants, not in words, but by acts and by something on the face of the articles, representing their goods as being the goods of the plaintiffs? . . . The law does not limit the form of the pretence; that depends upon the facts of each particular case." And an injunction was granted.

In the *Southern White Lead Co. v. Carey et al.*, O. G. U. S. Patent Office, Vol. 33, p. 624, Gresham, J., says: "I shall not stop to inquire whether the complainants' claim to the trade-marks is or is not well founded, as I think it is entitled to an injunction on another ground. The defendants so brand the heads of their casks as to naturally mislead, and induce persons purchasing for consumption to suppose that they are purchasing complainants' lead, when they are getting an inferior article. . . . The defendants manufacture their adul-

terated and greatly inferior lead at Chicago, and stamp upon their casks a false brand in imitation of the complainants' brand. Why is this done, unless it be in the hope of deceiving the public and injuring the complainants?" And an injunction was granted.

In *Trask Fish Co. v. Wooster*, 28 Mo. App. 408, an injunction was granted on the same grounds.

In *Avery & Sons v. Meikle & Co.*, 81 Ky. 73, the plaintiffs manufactured ploughs in the city of Louisville, and branded the ploughs of the steel series "Pony," "AO," "BO" and "CO," and those of the cast series " $\frac{1}{2}$ ," "1," "2," "3" and "8." The defendants also manufactured ploughs in Louisville, and branded their steel series "PO," "AO," "BO" and "CO," and their cast series " $\frac{1}{2}$ ," "1," "2," "3" and "8."

The Court held that there was no trade-mark here, but enjoined the defendants from the use of the plaintiffs' marks on the ground of fraud.

See also *Metcalf v. Brand*, 86 Ken. 346.

In *Woodward v. Lazar*, 21 Cal. 448, the defendant called his hotel the "What Cheer House," built another across the way, which he also called the "What Cheer House," and sold the first to the defendant, who put up a sign, "The Original What Cheer House." Although the defendant's sign was true, he was enjoined from its use.

In the *Royal Baking Powder Co. v. Jenkins et al.*, Price & Stewart Amer. T. M. Cases 309, the defendant used the word "Royalty" in connection with his baking powder, and imitated the boxes and labels of the plaintiff. An injunction was granted.

See also *Alexander v. Morse*, 14 R. I. 153; *Neff & Co. v. Radam*, 77 Texas 530; *Howard v. Henriques*, 3 Sand. N. Y. 725.

In *New York Cab Company v. Mooney*, 15 Abbott N. C. 152, the plaintiffs painted the lower body of its cabs yellow, and painted on the upper panel a crown with three feathers issuing out of it, encircled by a gold band bearing its name "New York Cab Company, Limited." The defendant painted his cabs the same color, and upon the upper panel painted a device, consisting of a gold band without feathers, containing the words "New York Cab, Limited." The defendant was restrained here. See also *Cooke v. Starkweather*, 13 Abb. Pr. N. S. 392.

In *Pierce v. Guillard*, 68 Cal. 68, the plaintiff manufactured an article called "German Sweet Chocolate." The defendant called his goods "Sweet German Chocolate" for the purpose of deceiving and securing the plaintiff's customers. The defendant was enjoined from the use of the words "Sweet German Chocolate," and this without reference to the question whether the plaintiff's label constituted a trade-mark. See also *Lea v. Wolf*, 13 Abb. N. S. 389.

In *Colton v. Thomas*, 2 Brewster 308, the plaintiff practised as a dentist under the name of the "Colton Dental Association." The defendant, who had been in his employ, put up a sign reading "Dr. F. R. Thomas, late operator at the Colton Dental Rooms," the words "late operator" being in very small letters. The defendant was enjoined from using such signs and words as represented his place of business to be the plaintiff's. See also *Saunders v. Jacobus*, Mo. App. 96.

In the *American Waltham Watch Co. v. The United States*

*Watch Co.*, Harvard Law Review, Feb., 1891, both plaintiff and defendant made watches at Waltham, the plaintiff having done so for many years, the defendant for but a short time.

The evidence proved to the Court that the defendants were trying unfairly to obtain the benefit of the plaintiff's reputation, and an injunction was granted against the use of the words "Waltham Watches" or "Waltham Watch" alone or in combination.

See also *Blue Store Clothing House* case in the same Review. The decisions of the Federal Courts are in line with the decisions above.

As long ago as 1844 Judge Story, though not drawing the distinction between trade-marks and cases analogous to them, granted relief in a case of the latter class: *Taylor v. Carpenter*, 3 Story 458.

The defendant had imitated the plaintiff's spools by coloring, stamping and labelling them in the same way the plaintiff had done, and had enclosed them in envelopes similar to the plaintiff's.

Judge Story granted an injunction to restrain the defendant from this imitation, and said, p. 463: "The case presented is one of unmitigated and designed infringement of the rights of the plaintiffs, for the purpose of defrauding the public, and taking from the plaintiffs the fair earnings of their skill, labor and enterprise."

In *Sawyer v. Horne*, 1 Fed. Rep. 24, the Court says: "But we do find that the respondent has been guilty of improper and inequitable conduct, to the injury of the complainant, in having designedly so put up, labelled, and packed his goods that purchasers, for whose use they are intended, are misled and deceived, and do get Horne's blue, when they

desire and suppose they are getting Sawyer's; and that Sawyer, the complainant, having, after many years of manufacture, established a market and a demand for his goods as known by their peculiar and distinctive appearance, which he was the first to adopt, is now deprived of profits which he would otherwise obtain, by the fact that after he had so established a reputation and demand for his goods, the defendant, with the intention of getting the benefit of that reputation and demand, has put his goods on the market, prepared with such close imitation of the complainant's that they are mistaken for his. . . . What we decide is that whether the complainant has a trade-mark or not, as he was the first to put up bluing for sale, in peculiarly shaped and labelled boxes adopted by him, and as his goods have become known to purchasers and are bought as the goods of the complainant by reason of their peculiar shape, color or label, no person has the right to use the complainant's form of package, color or label, or any imitation thereof, in such manner as to mislead purchasers into buying his goods for those of the complainant, whether they be better or worse in quality."

In *Hostetter et al. v. Adams et al.*, 10 Fed. Rep. 838, the facts were very similar, and here again equitable relief was granted, though there was no trade-mark. See also *Carbolic Soap Company v. Thompson*, 25 Fed. Rep. 625; *Royal Baking Powder Company v. John Davis et al.*, 26 Fed. Rep. 293; *Sawyer Crystal Blue Company v. Hubbard*, 32 Fed. Rep. 388.

In *Moxie Nerve Food v. Baumbach*, 32 Fed. Rep. 205, the plain-

tiff manufactured a beverage which he called "Moxie Nerve Food" and put it up in champagne bottles. The defendant was enjoined from using champagne bottles in connection with the term "Standard Nerve Food" for preparations similar in taste, color and flavor to the plaintiff's preparation. See also *Moxie Nerve Food Co. v. Beach*, 33 Fed. Rep. 248; *Jennings v. Johnson*, 37 Fed. Rep. 364; *Myers v. Thaller*, 38 Fed. Rep. 607; *Frese v. Bachof*, 13 U. S. Pat. Gaz. 635. Finally in *Putnam Nail Co. v. Bennett & Stubbs*, 43 Fed. Rep. 800, the plaintiff, the facts and the bill were the same as in *Putnam Nail Co. v. Dulaney*, at present under discussion; and the Circuit Court, in an oral opinion by Bradley, Circuit Justice, dismissed the demurrer to the bill. Chief Justice Fuller, in the very recent case of *Lawrence Manufacturing Co. v. Tennessee Manufacturing Co.*, 138 U. S. 537, cited this case with approval.

The Supreme Court of the United States has laid down and followed the same principle.

In *MacLean v. Fleming*, 96 U. S. 245, the plaintiff called pills made by him "Dr. C. MacLean's Celebrated Liver Pills," and used certain distinctive labels and wrappers for them, and the defendant was restrained from calling his pills "Dr. J. H. McLean's Universal Pills or Vegetable Liver Pills" or "Dr. McLean's Universal Pills" upon any label or wrapper for boxes or other packages of pills, resembling or in imitation of the labels or wrappers or trade-marks (trade-marks is here used in its broad sense) of the complainant. Clifford, J., said, p. 254: "Nor is it necessary, in order to give a right to an injunction, that a specific

trade-mark should be infringed; but it is sufficient that the Court is satisfied that there was an intent on the part of the respondent to palm off his goods as the goods of the complainant, and that he persists in so doing after being requested to desist."

In *Lawrence Manufacturing Co. v. Tennessee Manufacturing Co.*, 138 U. S. 537, Fuller, C. J., says, p. 549:

"Undoubtedly an unfair and fraudulent competition against the business of the plaintiff, conducted with the intent, on the part of the defendant, to avail himself of the reputation of the plaintiff to palm off his goods as plaintiff's, would, in a proper case, constitute a ground for relief," and then cites *Putnam Nail Co. v. Bennett*, *supra*, with approval.

So much for the cases. Sabastian on Trade-marks, p. 271, lays down very clearly the underlying principle: "Where, however, there has been a representation that one thing is another, by means of which one person has secured custom intended for another, so that both the purchaser and genuine trader have been defrauded, there the Court will interfere and protect the right of both parties to trade freely without fraudulent deceptions, although the fraud has taken another form than that of imitating a trade-mark."

Do these cases and the principle on which they are decided apply to the two Pennsylvania cases at present under discussion?

It is the purpose of this article to show, if possible, that they do. In *Putnam Nail Co. v. Dulaney*, to take the cases up one at a time, the bill averred that the plaintiff bronzed certain nails made by it; that this bronzing did not make



the nails intrinsically any better, but was done so that purchasers could distinguish its nails readily at sight; that the defendant had imitated this bronzing for the purpose of filching purchasers from the plaintiff; and that, in fact, purchasers had been deceived by the imitation. The Court, in a learned opinion by Paxson, Chief Justice, says that there is no valid trade-mark here, and hence no rights of the plaintiff have been infringed. Perhaps there was no infringement of a trade-mark; but neither was there in the cases cited above, in which the Courts over and over again granted relief, for the simple reason that the defendants had fraudulently imitated certain distinctive marks, etc., which the plaintiffs had adopted, whereby purchasers had been deceived, so that they had bought the defendants' goods, thinking they were the plaintiffs'. The learned Chief Justice remarks: "Some of the cases cited go so far as to restrain one manufacturer from imitating the style, form and size of the packages of other manufacturers. We need not discuss these cases, for they are not applicable." But why are they not applicable? In these cases the defendants imitated the plaintiffs' packages to enable them to pass off their goods as the plaintiffs'. In the present case the defendant bronzed his nails for precisely the same purpose.

It is true that in these cases the particular imitation of this case, to wit, bronzing horseshoe-nails, was not before the Courts, but there is no intimation in these cases that relief should be granted only where style, form and size of packages are imitated. Relief is not granted

because any one mark, etc., is imitated, but because the imitation, on the whole, is such as to confuse purchasers, and the law is broad enough to cover all cases in which this imitation is established. As Barrett, J., says in *Morgan's Sons & Co. v. Troxell*, Cox's Man. T. M. Cases, No. 674: "The law does not limit the form of pretence: that depends upon the facts of each particular case."

Why should relief be granted where part of the imitation restrained consists of painting an omnibus or cab a particular color, or using the defendant's own name in a way to deceive, or using a certain expression or label, box or package for the same purpose (see cases cited above), and not where bronzing nails is the deception? It is submitted that the distinction is one consisting of simply the facts used to bring about the deception and not one of principle. The essential elements of the case cited above — fraudulent imitation and deception of purchasers—is present in this case. It can make no possible difference that the imitation is limited to one particular instead of consisting of an imitation in several particulars.

From the nature of horseshoe-nails, bronzing them in itself is enough to deceive purchasers, and that is sufficient to entitle the plaintiffs to relief if deception actually follows from the bronzing.

If bronzing made the nails intrinsically better, then, inasmuch as bronzing cannot be patented, the plaintiffs would have no case; but the bill specifically avers that the bronzing does not make the nails intrinsically more valuable, so the fact that bronzing cannot be patented makes no difference.

The plaintiff in this was clearly entitled to relief under the cases cited above, unless to apply the law of cases analogous to trade-marks in this particular case would be carrying the principle too far. The Circuit Court of the United States, in *Putman Nail Co. v. Bennett*, cited with approval by the Supreme Court of the United States, in which the facts and bill were identical with the facts and bill of the present case (see above), decided that the facts set forth in the plaintiff's bill entitled it to relief. Said Mr. Justice Bradley : "Now, a trade-mark, clearly such, is in *itself* evidence, when wrongfully used by a third party, of an illegal act. It is of itself evidence that the party intended to defraud, and palm off his goods as another's. Whether this (bronzing nails) is in itself a good trade-mark or not, it is a style of goods adopted by the complainants which the defendants have imitated for the purpose of deceiving, and have deceived the public thereby, and induced them to buy their goods as the goods of the complainants. This is fraud."

The Court then dismissed the demurrer.

Of course this Circuit Court case is not a binding precedent for the State Court ; but it would perhaps have been more satisfactory on the whole if the State Court had carefully analyzed the reasoning of the Federal Court, and had triumphantly shown wherein it was erroneous, and then shown wherein its own reasoning was superior. But instead of this, the State Court dismissed the plaintiffs' bill in an opinion in which the doctrine of cases analogous to trade-marks is totally ignored, in which not one name, and in which the Circuit Court case, pre-

sumably, is dismissed with the remark that it is not an authority binding on the State Court.

The case of *Hoyt v. Hoyt* is even stronger, for here the Court would not have had to apply the law of cases analogous to trade-marks to a new set of facts, for the imitation sought to be restrained in this case was practically identical with that of many cases previously decided. The plaintiffs' bill prayed for an injunction restraining the defendants from using the word "Hoyt's" in connection with the sale and manufacture of cologne, and from imitating the bottle caps, labels, advertisements and packages used by the plaintiffs.

The Master and Court below found that "the defendants have intentionally adopted bottles, labels and a method of packing to imitate the plaintiffs' manufacture, and to induce innocent purchasers to buy cologne manufactured by the defendants under the belief that the cologne that they purchased has been manufactured by the plaintiffs," and on this state of facts granted an injunction to restrain the defendants from this imitation and from using the word "Hoyt's" as the initial word of the description of their cologne. There was no attempt on the part of the Supreme Court to review the evidence and prove that it did not support the Master's finding, so the facts must be taken as the Master found them.

In *Sawyer v. Horne* (see above) the defendants were restrained from imitating the packages and labels of the plaintiff, and in *McLean v. Fleming* (see above) the defendant was restrained from the use of a name to which he had a right, except for the fact that in this case it was fraudulently used. Many

of the other cases cited above were decided upon a similar state of facts.

In *Hoyt v. Hoyt*, as in *Putnam Nail Co. v. Dulaney*, the Supreme Court of Pennsylvania refused to grant the relief prayed for.

It may be well to review the opinion of the Court.

The learned Judge says: "As a general proposition, it may be said that one may imitate what is excellent in the processes and business methods of his neighbor as freely and safely as he may imitate what is good in his moral character, as long as he infringes no right secured to him by statute, and does not fraudulently personate him or simulate his products." The last clause—fraudulent simulation of another's products—seems to recognize the law of cases analogous to trade-marks, and it would seem that the present case was one for its application, because the Master found that the defendants had intentionally adopted bottles, etc., to imitate the plaintiffs' manufacture, and induce purchasers to buy the defendants' cologne under the impression that they were buying the plaintiffs'. But the Court did not think so, and dismissed the subject without any attempt to explain why the fraudulent imitation of another's goods or products in the present case should not be restrained. The learned Judge then takes up the question of trade-marks and patents, and says that, as there is in the case no infringement of a trade-mark or no patent, the plaintiff is entitled to no relief. And what he says would be conclusive if the law did not go beyond the infringement of a trade-mark or patent. But, as the cases cited above abundantly show, the law

grants relief upon much broader grounds where there is fraudulent imitation of another's marks, etc., and this principle of relief on broader grounds the learned Judge totally ignores in spite of the numerous cases in which relief has been granted, where the facts were practically identical with those in the present case. In another part of the opinion the learned Judge takes up the question of the use by the defendants of the word "Hoyt's," and cites the opinion of the Court below to the effect that the defendant had a right to the use of his own name in his business, and that he could not be enjoined from using it on goods produced by himself. "The correctness of this holding," says the opinion, "is not raised by the defendant's appeal."

The Court has here fallen into a curious error. It is true that the Court below held that the defendant had a right to the use of his own name, and refused to restrain him from its use. But the Court so held in an opinion delivered when the *preliminary* injunction was granted.

The Master, after hearing the evidence, decreed that the defendants be restrained from using the word "Hoyt's" as the initial word of the description of their cologne upon any advertisement, label or bottle, and the Court below affirmed the decree of the Master, and granted a *perpetual* injunction, restraining the defendants from the use of the word "Hoyt's" under the circumstances set forth by the Master. In other words, the learned Judge cites what the Court below decided at an early stage of the case, when in fact the Court finally decided something entirely different.

In these two cases the Supreme Court of Pennsylvania has totally ignored the law of cases analogous to trade-marks—the law which restrains the fraudulent imitation by one man of the distinctive marks, etc., adopted by another to distinguish his goods—and that although this law is firmly established elsewhere by the Courts of highest authority in England and in this country. If the Court had discussed this principle of law carefully and shown that an advanced public policy demanded that the Pennsylvania Court should refuse to follow the decisions of the other Courts, one would sympathize with its stand. But there is no such discussion in the opinion in these cases.

“Whether trade rivalry shall be

open and fair, so that each may be stimulated to his best endeavor in knowledge that his exertions will bring him to the full the honor and profit which are his due, or whether fraud, which knows how to evade definite rules, shall reap the fruits of honest labor and hardly won reputation, is within the discretion of the Court:” G. D. Cushing, Esq., in the *Harvard Law Review* for Feb., 1891, p. 332. It is respectfully submitted that in these cases the Pennsylvania Court has misused its discretion and taken a wrong stand, and that these two decisions are much to be deplored, for it is difficult to see how their effect will not be to encourage one branch of commercial dishonesty.

WILLIAM WHARTON SMITH.

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*Supreme Court of Oregon.*

OREGON *ex rel.* EVERETT *v.* BOURNE.

*Decided November 2, 1891.*

SYLLABUS.

Where a witness whose testimony is required in a cause pending in a court of justice is within the territorial jurisdiction of a foreign Court, it is the duty of the foreign Court, when properly requested so to do by the Court in which the suit is pending, to require the attendance of the witness before a regularly commissioned officer, and there to compel him to answer such interrogatories as have been propounded.

The jurisdiction of the foreign Court in such cases is based upon that principle of the law of nations which requires the courts of different countries to assist each other for the furtherance of justice, and such jurisdiction may be exercised independently of local law.

Therefore when a Circuit Court in Oregon, in compliance with letters rogatory issued out of a Superior Court in Massachusetts, ordered the witnesses designated in the letters to appear before a commissioner, which order the witness disobeyed :

*Held*, that the Court below was justified in committing the refractory witness for contempt, and imprisoning him till he should comply with the order.